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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN T. CONNELLY

Appeal 2009-1099
Application 10/613,946
Technology Center 3600

Decided: March 16, 2009

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claim(s) 1, 4, and 9-11.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ Claims 2, 3, 5-8, and 12-16 are also pending, but stand withdrawn from consideration (App. Br. 5).

STATEMENT OF THE CASE

The claims are directed to a shade and rain umbrella. Claim 1 is representative of the claims on appeal, and reads² as follows:

1. A shade and rain umbrella combination including a basic umbrella having a shaft and expanding ribs at a top of said shaft, a shade cover placed over said ribs and fastened to a peripheral point at the end of said ribs, said shade cover consisting of a woven mesh fabric for protection against ultraviolet rays of the sun but at the same time allowing ventilation air to pass through said fabric, a separable water proof rain cover is placed over said shade cover in the event of rain, said rain cover is substantially the same size as said shade cover, means for fastening said rain cover to said peripheral point at each of the ends of said ribs, whereby said shade is used in sunshine and said rain cover is added in the event of rain but separate otherwise.

The Examiner relies on the following evidence:

Johnson	US 5,487,401	Jan. 30, 1996
Bilotti	US 5,678,587	Oct. 21, 1997
Kupferman	US 5,890,506	Apr. 6, 1999
Allee	US 6,378,539 B1	Apr. 30, 2002

We affirm, but as our rationale differs from that of the Examiner, we designate our affirmance a new ground of rejection.

ISSUE(S)

The Examiner concludes that claims 1 and 4 are rendered obvious by the combination of Johnson, Kupferman, and Bilotti; and that claims 9-11 are rendered obvious by the combination of Johnson, Kupferman, and Bilotti, as further combined with Allee.

² See Corrected Claims Appendix, dated May 21, 2008.

Appellant contends that the combination of references cited by the Examiner does not render obvious the claimed umbrella.

The issue on appeal is therefore: Does the combination of references cited by the Examiner render obvious the claimed umbrella?

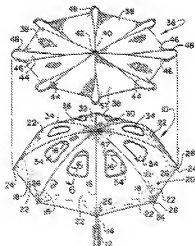
FINDINGS OF FACT

FF1 The Examiner rejects claims 1 and 4 under 35 U.S.C. § 103(a) as being obvious over the combination of Johnson, Kupferman, and Bilotti (Ans. 3).

FF2 The Examiner cites Johnson for teaching an umbrella, which, according to the Examiner, may be used as shade umbrella and a rain umbrella (Ans. 3).

FF3 Johnson is drawn to an umbrella that is resistant to inversion from wind (Johnson, col. 1, 13-15).

FF4 Figure 1 of Johnson is reproduced below:



FF5 Figure 1 is an exploded, perspective view of the umbrella of Johnson (*id.* at col. 4, l. 37).

FF6 The umbrella has a shaft (center post 14), a stationary hub 30 at the top end of the shaft, to which a plurality of ribs are attached (*id.* at col. 5, ll. 45-58).

FF7 The umbrella includes a lower canopy 20 made from a water resistant material, and has vent holes 34 (*id.* at col. 6, ll. 1-46).

FF8 The umbrella also includes an upper canopy 36 also made of water resistant material, which has a smaller dimension in the radial direction than the lower canopy 20 (*id.* at col. 6, ll. 42-47). The upper canopy has a strap of elastic material 48 which may be slipped over the end of a rib 18 (*id.* at col. 6, ll. 57-67).

FF9 Thus, Johnson teaches an umbrella that includes a shaft and expanding ribs at the top of said shaft, having a cover with vent holes placed on the ribs. Johnson also teaches an upper water resistant canopy having means for attaching the upper canopy to the peripheral point at the ends of the ribs.

FF10 The umbrella shown in Figure 1 of Johnson differs from the umbrella of claim 1 in that it does not have a lower canopy of a woven mesh fabric, and the upper canopy is not substantially the same size as the lower canopy.

FF11 Johnson, teaches however, that the prior art discloses an umbrella having a lower canopy with a plurality of holes that permit some sunlight to reach the user, and an outer canopy that may be used to cover the opening, wherein the outer canopy has a plurality of holes around the peripheral edge

through which the tips of the ribs can extend to hold the outer canopy in place (*id.* at col. 2, ll. 23-34).

FF12 Johnson further notes that umbrellas with two canopies or a detachable canopy used for aesthetic or other purposes are known in the art (*id.* at col. 2, ll. 41-44).

FF13 The Examiner cites Kupferman for teaching an umbrella in which the lower portion comprises a woven mesh fabric (Ans. 3-4).

FF14 Kupferman is also drawn to an umbrella that is resistant to inversion from wind (Kupferman, col. 1, ll. 4-10).

FF15 Figure 5 of Kupferman is reproduced below:

FIG. 5

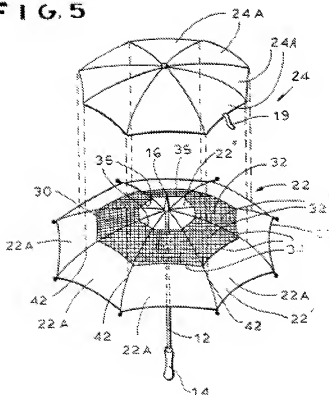


Figure 5 is an exploded view of the umbrella of Kupferman, showing the upper and lower canopies disassembled (*id.* at col. 5, ll. 1-3).

FF16 The opening 30 in the lower canopy 22 is filled by an air transmissible, flexible mesh material (*id.* at col. 5, ll. 37-50).

FF17 The Examiner cites Bilotti for teaching a shade cover made of a woven mesh fabric coated with ultraviolet protecting material (Ans. 4).

FF18 Specifically, Bilotti teaches an umbrella net in which the netting is coated with an ultraviolet insulating material to resist the rays of the sun (Bilotti, col. 4, ll. 17-24).

FF19 The Examiner then rejects claims 9-11 under 35 U.S.C. § 103(a) as being obvious over the combination of Johnson, Kupferman, and Bilotti, as further combined with Allee (Ans. 4).

FF20 Claims 9-11 further require a means for clamping the shaft of the umbrella in an upright position on an object, such as by means of a C-shaped clamp.

FF21 The Examiner notes that Johnson also teaches an umbrella having a handle that may have a variety of configurations that may be used to attach the umbrella to another structure (Ans. 5).

FF22 The Examiner cites Allee for teaching an umbrella comprising a shaft, wherein a C-shaped clamping device is provided for attaching the shaft in an upright position to a support device (*id.*).

FF23 The Examiner concludes that it would have been obvious to use the clamping device of Allee on the umbrella taught by the combination of Johnson, Kupferman, and Bilotti in order to allow the umbrella to be attached in an upright position to different support surfaces.

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1739 (2007).

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at ___, 127 S. Ct. at 1740. It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

Id. at ___, 127 S. Ct. at 1741. *See also id.* at ___, 127 S. Ct. at 1742 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). “In determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

ANALYSIS

As to the rejection of claims 1 and 4, Appellant argues that Johnson does not disclose the concept of a two mode use of an umbrella, as all Johnson discloses is a windproof umbrella (App. Br.³ 7). Moreover, Appellant asserts, the upper canopy of the umbrella of Johnson has a dimension smaller than that of the lower canopy (*id.*).

Appellant argues further that Kupferman also does not mention a sun cover and a rain cover, as again, the umbrella of Kupferman is a wind resistant umbrella (*id.* at 8). There is then no reason to combine Johnson and/or Kupferman with Bilotti, as Johnson and Bilotti are not drawn to using the umbrellas as a sun shade (*id.* at 9).

We acknowledge that Johnson and Kupferman are both drawn to a “single mode” umbrella that has increased wind resistance. But, the umbrella shown in Figure 1 of Johnson teaches all the structural limitations of the umbrella of claim 1 (FF9) except for teaching that the lower canopy consists of a woven mesh fabric, and that the upper canopy is substantially the same size as the lower canopy (FF10).

Kupferman also teaches an umbrella that has increased resistance, wherein a woven mesh material is used in the lower canopy (FF16). Bilotti is evidence that it is known in the art that a woven mesh material can provide protection from the sun. We note further that Johnson teaches that umbrellas used as a sun shade were known in the prior art (FF11), and also

³ All references to the Appeal Brief (App. Br.) are to the “Third Substitute Brief on Appeal” dated February 21, 2007.

teaches that umbrellas with a detachable canopy were known in the art (FF12).

Taking into account the inferences and creative steps that the ordinary artisan would employ, we conclude it would have been obvious to one of ordinary skill in the art to provide a lower canopy consisting of a woven mesh material in the umbrella of Johnson and/or Kupferman in order to provide an umbrella that allows ventilation to the use, but also provides protection from the sun, as Bilotti teaches that such woven material may provide protection from the sun. It would have also been obvious to use a detachable upper canopy that is made of a waterproof material to allow the umbrella to be useful for sheltering the user from rain, and the mesh material would also allow the umbrella to be more wind resistant as taught by Johnson. Such modifications would have well within the level of skill in the art given the teaching of Johnson that umbrellas were known in the art to be used for both protection from the sun and protection from the rain.

In addition, once the lower canopy is made of a woven mesh material, it would have been obvious to provide an upper water resistant canopy that is substantially the same size as the lower canopy in order to cover all of the mesh and protect the user. In addition, as noted by Johnson, umbrellas having an outer canopy that has a plurality of holes around the peripheral edge through which the tips of the ribs can extend to hold the outer canopy in place (FF11), and thus the upper canopy is substantially the same size as the lower canopy, were known in the art.

As to the rejection of claims 9-11 over the combination of Johnson, Kupferman, and Bilotti, as further combined with Allee, Appellant reiterates

the arguments made with respect to the rejection of claims 1 and 4. Thus, we affirm this rejection for the reasons set forth above.

CONCLUSION(S) OF LAW

We conclude that the combination of references cited by the Examiner renders obvious the claimed umbrella.

We thus affirm the rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as being obvious over the combination of Johnson, Kupferman, and Bilotti. But as our reasoning differs from that of the Examiner, we designate our affirmance as a new ground of rejection.

In addition, as Appellant did not separately argue the rejection, we also affirm the rejection of claims 9-11 under 35 U.S.C. § 103(a) as being obvious over the combination of Johnson, Kupferman, and Bilotti, as further combined with Allee.

TIME PERIOD FOR RESPONSE

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejections of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED; 41.50(b)

Appeal 2009-1099
Application 10/613,946

cdc

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